

REMARKS

Upon entry of the amendments in this reply, claims 1-17 and 19-32 will be pending in this application. In this Action, the Office has withdrawn the prior restriction applied to claims 1-10 and provided a first examination of these claims. The Office rejected claims 11-17 and 19-20 under 35 USC § 102(a) as being anticipated by Morrison et al. (EP No. 1 098 277 A2). Additionally, claims 1-10 and 21-31 are rejected under 35 USC § 103(a) as being unpatentable over O'Brien et al. (U.S. Pat. No. 5,555,060) in view of Morrison. This Action has been made final and is responsive to Applicant's communication filed on or about October 5, 2005.

Applicant filed a reply to this Office Action on March 6, 2006. The Office responded on April 5, 2006, maintaining the rejections and stated the proposed amendments requires further consideration. The Office failed to respond to Applicant's claim of that the final rejection was premature. Applicant maintains the final rejection was premature and asks the Office to withdraw the finality of the rejection and reopen prosecution. Applicant has filed an RCE with this reply but asks the Office to refund the cost of the RCE upon a favorable ruling on the premature final rejection.

Premature Final Rejection

The Office has made this action final and asserted that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." Applicant disagrees. Claims 1-10 have only been considered and rejected once by the Office. These claims were withdrawn from previous consideration due to a restriction required by the Office and only reinstated in this Office action. The MPEP (706.07(a)) states "on the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final." Claims 1-10 have not received a second examination nor have they been twice rejected, therefore making the rejection final was indeed premature. The Office's failure to allow two examinations of these claims has deprived Applicant of the right to make amendments after a first rejection and then have those amendments considered by the Office. Applicant requests that the Office withdraw the finality of this rejection and reopen prosecution.

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Claim Amendments

Applicant requests that the amendments to the claims be entered into this application. No new matter is being added. Support for the changes and the new claim is found in the specification e.g., page 2, line 8 – page 3, line 8 and Fig. 2C.

102(a) Rejection of Independent Claims 11 and 17 Over Morrison

The Office's rejection is moot in view of the amendments made to these claims. Morrison does not show or suggest "moving a first component of a convertible checkout station to a position relative to a second component of the convertible checkout station to generate a configuration signal that indicates a physical configuration of the checkout station where the movement of the first component changes the physical configuration of the checkout station," as now required by Applicant.

103 Rejections of Claims 1 and 21 Over O'Brien and Morrison

To establish a *prima facie* case of obviousness, at least the following requirements must be met: (1) there must be some motivation or suggestion to combine the referenced teachings; and (2) the references when combined must teach or suggest all elements of the claimed subject matter. See *M.P.E.P.* § 2143 (8th ed., Rev. 2), at 2100-129. The Office Action has not established a *prima facie* case of obviousness with respect to independent claims 1 and 21 because neither requirement can be satisfied.

Regarding obviousness requirement one, O'Brien teaches "the invention relates generally to the field of actuator position control sensors, and in particular to a control system for self calibration of actuator position control sensors useful in camera shutters, iris diaphragm controls, zoom lens deployment actuators and the like." O'Brien clearly states that his teachings relate to cameras and the special requirements needed to operate the shutter of a camera. Morrison on the other hand, teaches a convertible checkout system that comprises a terminal, bar code scanner, card reader, input belt, and drawer. Morrison's convertible checkout system is concerned with converting the checkout system from self-service to customer assisted configuration. The two references have different teachings to solve complete different problems with different solutions. A

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person of ordinary skill in the art of camera shutter controls would have absolutely no reason or motivation to look to a reference on a convertible checkout system for any solutions or for a place to use the invention. There is simply nothing in either O'Brien or Morrison that would suggest or motivate a person of ordinary skill in the art of camera controls or in convertible checkout systems to look to the other reference. Furthermore, there is no teaching or suggestion in Morrison that a feature related to shutter controls is missing or yet to be solved. Applicant can find no suggestion within Morrison that a sensor for sensing the position of the components of the convertible checkout station is needed. Instead, Morrison teaches that a customer service manager toggles the supervisor switch to enter this information. Therefore, there is no motivation or suggestion to combine these references. At least this requirement is missing.

Regarding obviousness requirement two, neither O'Brien or Morrison show or suggest "detecting a spatial relationship between at least two components of a convertible checkout station," as required by Applicant. Morrison does not show or suggest detecting the spatial relationship between at least two components of a convertible checkout station because it relies on a customer service manager to provide this information. (Note: In the action, the Office incorrectly refers to O'Brien as Gellner.) The Office states that "Gellner is not intended to generate such a configuring signal to control a convertible checkout." (Page 6, last paragraph.) It is clear that O'Brien's teaching is designed for specific camera functions and not for convertible checkout system. Therefore, neither O'Brien or Morrison together or separately show or suggest the all the elements of Applicant's claims and at least this requirement is missing.

Having failed to establish either of the two required parts of a *prima facie* case of obviousness, the rejection is improper and the claims are allowable over these references.

Dependent Claims

Claims depending from independent claims are allowable for at least the same reasons presented above.

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CONCLUSION

Applicant's claims are allowable over the prior art made of record. Applicant asks the Office to reconsider this application and allow all claims. Please charge any fees that might be due, excluding the issue fee, to the NCR deposit account 14-0225.

Respectfully,

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